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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,217	03/12/2004	Robert M. Tessari	CBENN.00006	2245
22858	7590	12/13/2005		
CARSTENS & CAHOON, LLP P O BOX 802334 DALLAS, TX 75380			EXAMINER BATES, ZAKIYA W	
			ART UNIT 3676	PAPER NUMBER

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/799,217	TESSARI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Zakiya W. Bates	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07162004,02142005</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 2/14/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Canada on 3/13/03, 3/31/03, and 4/17/03. It is noted, however, that applicant has not filed a certified copy of the applications as required by 35 U.S.C. 119(b).

### ***Specification***

3. The abstract of the disclosure is objected to because the term "is also described" is stated in line 11. Correction is required. See MPEP § 608.01(b).

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

5. Claims 12-25 are objected to because of the following informalities: claim 12, line 10, the term "lateral bore" should be replaced with --lateral port-- for consistency purposes, and to provide antecedent basis for the term in line 12. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,679,336.

US'336 discloses an apparatus that includes, with respect to claim 1, a borehole drilling apparatus comprising: a drill string 11 including a center bore and a distal end; a bit assembly (col. 6, line-62 - col. 7, line 24) at the drill string's distal end; a ported sub 14 mounted on the drill string, the ported sub including an upper surface, a lower

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surface, a bore extending from the upper surface to the lower surface to which the drill string is connected, an axially extending port 30 for providing fluid communication between the lower surface and the upper surface separate from fluid communication with the bore and a lateral port 33 for providing fluid communication between the drill string center bore and an outer surface of the sub between the upper surface and the lower surface, the lateral port being substantially isolated against fluid communication with the axially extending port during operation; and a liner engaging surface encircling the lower surface, the liner engaging surface formed to releasably secure a borehole liner 25 such that the drill string extends through the borehole liner with the bit assembly extending beyond a liner shoe 20, 40 of the liner with an opening between the drill string and the liner. With respect to the depending claims, the reference teaches the limitations as claimed, including a seal 21A, (cement or o-ring in 47), valves 31, and passages. With respect to claim 12, the reference discloses an apparatus for drilling a borehole defined by a borehole wall, the apparatus comprising: a drill string 11 including a center bore and a distal end; a bit assembly at the drill string's distal end; a liner 25 including an upper end and an inner bore and the liner being arranged with the drill string extending through the liner inner bore; a ported sub 14 mounted between the drill string and the liner to support the liner on the drill string, the ported sub including an upper surface, a lower surface about which the liner is connected, a bore extending from the upper surface to the lower surface through which the drill string is connected to the ported sub, an axially extending port 30 for providing fluid communication between the liner inner bore and an upper opening to the upper surface of the sub, a lateral port

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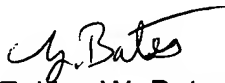
33 providing fluid communication between the drill string center bore and an outer surface of the sub between the upper surface and the lower surface, the lateral port being substantially isolated against fluid communication with the axially extending port during operation; and a seal 21A, (in 47), adjacent the upper end of the liner and selected to seal against fluid flow upwardly about the liner upper end from an annulus formed between the liner and the borehole wall. With respect to the depending claims, the reference teaches the limitations as claimed, including a seats, valves 31, and passages. With respect to claim 26, the reference discloses a method for drilling a borehole comprising: providing a drill string of including a center bore, a distal end, a bit assembly at the distal end; hanging a liner from the drill string, thereby forming an annular space between the drill string and the liner and with the bit assembly extending from a lower end of the liner; positioning the drill string with the liner attached thereto in a borehole such that a second annular space is formed between the liner and the borehole wall; operating the bit assembly to proceed with drilling the borehole; and circulating drilling fluid down through the center bore of the drill string out through the bit assembly and down through the second annular space between the liner and the borehole wall, the drilling fluid returning up through the annular space between the drill string and the liner. With respect to the depending claims, the reference teaches the limitations as claimed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya W. Bates whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Zakiya W. Bates  
Primary Examiner  
Art Unit 3676

zb  
December 8, 2005